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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,830	03/08/2004	James E. Grimm	ZIM0417	2799
7590 10/05/2007				
John F. Hoffman, Esq. BAKER & DANIELS LLP 111 East Wayne Street, Suite 800 Fort Wayne, IN 46802				
			EXAMINER PRIDDY, MICHAEL B	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 10/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/795,830	Applicant(s) GRIMM ET AL.	
	Examiner Michael B. Priddy	Art Unit 3733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-26 is/are pending in the application.
- 4a) Of the above claim(s) 5-7, 20, 22, 24 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4, 8-10, 15-19, 21, 23 and 25 is/are rejected.
- 7) ☒ Claim(s) 11-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

Applicant submitted a petition to accept an unintentionally delayed claim under 25 U.S.C. § 120 on 04/02/2007. This petition has been granted. Therefore, the prior art reference (US 2004/0122305) to Grimm et al. does not constitute prior art. The previous rejection under 35 U.S.C. § 102(e) has been withdrawn and a new ground of rejection has been established below.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for tracking (claim 15) and the multiple sensors (claim 16) of which it is comprised must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2, 3, 8-10, 15-19, 21, 23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Couture et al. (U.S. 2004/0039396 A1). Couture et al. teach a surgical system for use during an orthopaedic surgical procedure at a surgical site of a patient's body, the system comprising: a surgical navigation system including multiple sensors for tracking the position of an object during a surgical procedure (CAS of paragraph 0036); a navigated orthopaedic guide 16/10/14 including means 16 for being tracked by the surgical navigation system to guide positioning of the orthopaedic guide at a desired position relative to the surgical site, the orthopaedic guide including means

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10/14 for establishing a datum at a desired position relative to the surgical site; and a surgical component 14/55/59 including means 55 for engaging the datum positioned by the orthopaedic guide to locate the surgical component 55/59 at a desired position relative to the surgical site; wherein the means 16 for being tracked comprises an electromagnetic coil 17 attached to the orthopaedic guide 16/10, the electromagnetic coil 17 producing a signal detectable by the means for tracking; wherein the means 10 for establishing a datum comprises a drill guide 36 to guide a drill in forming a hole in a bone at the surgical site; wherein the means 10 for establishing a datum comprises at least one hole 36 in the orthopaedic guide to guide placement of a pin adjacent the surgical site; wherein the surgical component comprises a cut guide 59 to guide a cutter to cut a bone to receive an implant; wherein the cut guide 59 comprises a distal femoral cut guide; wherein the means 55 for engaging the datum comprises at least one hole (surrounding element 61) formed in the surgical component to receive the datum in the form of a pin; wherein the means 10/14 for establishing a datum includes a base member 10 and a datum guide member 14 connected to the base member such that the position of the datum guide member 14 is adjustable relative to the base member 10 to a desired datum guide member position as indicated by the surgical navigation system; wherein the base member 10 is able to be secured to a distal portion of a femur and the datum guide member 14 is adjustable relative to the base member 10 to establish a datum having a desired flexion-extension and varus-valgus angles as indicated by the surgical navigation system; wherein the base member 10 is also able to be secured to a proximal portion of a tibia and the datum guide member is adjustable

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relative to the base member to establish a datum having a desired posterior slope and varus-valgus angles as indicated by the surgical navigation system; wherein the means for establishing a datum comprises a guide body including a plurality of holes 36 through the body for guiding the placement of pins relative to the surgical site.

### ***Allowable Subject Matter***

Claims 11-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

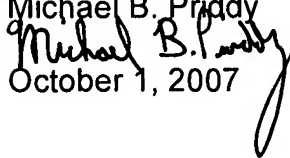
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is 571-272-2243. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael B. Priddy  
  
October 1, 2007

  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER